

U.S. Patent Application No. 09/833,432
Attorney Docket No. 13DV-13932 (07783-0078-01)

REMARKS

The Office Action mailed May 20, 2005 has been received and carefully considered. Claims 1-6 and 8-21 are currently pending. Claims 1-6, 8 and 21 stand rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. Claims 1-6, 8-14 and 17-21 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent 6,178,430 to Cohen et al. (Cohen) in view of U.S. Patent 6,327,628 to Anuff et al. (Anuff). Claims 15 and 16 stand rejected under 35 U.S.C. § 103(a) as obvious over Cohen and Anuff in further view of U.S. Patent 5,870,744 to Sprague (Sprague).

I. Amendments to the claims.

Claims 1, 9 and 21 have been amended. It is believed that the amendments overcome the informalities objected to by the Examiner with respect to the capitalization of the term "Intranet."

II. Rejection under 35 U.S.C. §101.

Claims 1-6, 8 and 21 stand rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. Specifically, the Examiner now alleges for the first time that the limitations found in independent claims 1 and 21 are not patentable subject matter and are directed to an abstract idea and can be carried out on paper. See Office Action at page 3.

Applicants disagree with the Examiner's recent assessment that the claims as originally presented were directed to an abstract idea. Rather, Applicants maintain that the claims were, and remain, directed to statutory subject matter: the claims provide specific steps to achieve a stated goal, which steps, when completed, lead to a tangible result. Nevertheless, in an attempt to expedite the prosecution of the case, Applicants have amended claims 1 and 21 to specifically state that the claimed method is executable over a computer network.

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Applicants respectfully request that the rejection under 35 U.S.C. §101 be withdrawn.

III. Rejection under 35 U.S.C. § 103(a).

A. Claims 1-6, 8-14 and 17-21

Claims 1-6, 8-14 and 17-21 stand rejected as obvious over Cohen in view of Anuff.

Applicants respectfully traverse the rejection.

Specifically, the Examiner has alleged that with respect to independent claims 1 and 21, Cohen teaches a method for determining a standards document to be added to an intranet portal, but admits Cohen fails to teach a module to be added to an intranet portal or an administrator to determine a module to be added to the portal. Office Action at pages 4-5. The Examiner further alleges that Anuff overcomes these deficiencies and that it would have been obvious to modify the method of Cohen with the teachings of Anuff as a result of a motivation to reduce portal maintenance costs. Office Action at page 5.

With respect to independent claim 9, the Examiner has stated that the claimed invention is a computer program product version of the claimed method, having all the limitations of the method found in claim 1 and therefore is also anticipated by Cohen. Office Action at page 7.

Applicants do not claim a method for determining standards documents, rendering the Cohen reference nugatory in any event. Further, Cohen does not add the standards documents to an intranet portal. Rather, in Cohen, the intranet is merely a conduit by which the standards documents are transferred.

As understood by Applicants, Cohen is directed to an automated information technology standards management system for managing information standards that specify the procedures by which data is stored, manipulated and retrieved within a computer system. Cohen, Abstract. Cohen describes an invention that downloads standards documents to a network server and

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connects the standards document into a HTML document. Col. 3, lines 1-4. The HTML document can then be displayed to users and the users provide management services that permits users to require changes, exceptions or variances to the standards document. Col. 3, lines 5-11.

Claims 1, 9 and 21 of Applicants' claimed invention, and consequently all claims depending therefrom, are directed to processes and computer programs involving modules in an intranet portal. That is, claims 1 and 21 are each directed to a method for determining a module to be added to an intranet portal and claim 9 is directed to a computer program product for updating a module in an intranet portal. Thus, from a threshold analysis, Applicants' claimed invention has a key distinguishing feature from Cohen: Cohen merely uses an intranet as a vehicle by which internal communications are relayed for modifying information standards. Revising the rejection of the Office Action of September 23, 2004 by adding Anuff fails to overcome this very basic deficiency.

The present rejection is a §103 combination rejection. It is well established that a proper §103 combination rejection requires more than just finding teachings in the references of the elements recited in the claim (but which was not done here). To reach a proper teaching of an article or process through a combination of references, there must be stated an objective motivation to combine the teachings of the references, not a hindsight rationalization in light of the disclosure of the specification being examined. MPEP 2143 and 2143.01. See also, for example, In re Fine, 5 USPQ2d 1596, 1598 (at headnote 1) (Fed.Cir. 1988), In re Laskowski, 10 USPQ2d 1397, 1398 (Fed.Cir. 1989), W.L. Gore & Associates v. Garlock, Inc., 220 USPQ 303, 311-313 (Fed. Cir., 1983), and Ex parte Levengood, 28 USPQ2d 1300 (Board of Appeals and Interferences, 1993); Ex parte Chicago Rawhide Manufacturing Co., 223 USPQ 351 (Board of Appeals 1984). As stated in In re Fine at 5 USPQ2d 1598:

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"The PTO has the burden under section 103 to establish a prima facie case of obviousness. [citation omitted] It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

And, at 5 USPQ2d 1600:

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

Following this authority, the MPEP states that the examiner must provide such an objective basis for combining the teachings of the applied prior art. In constructing such rejections, MPEP 2143.01 provides specific instructions as to what must be shown in order to extract specific teachings from the individual references:

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)."

"A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not

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sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)."

Here, the Examiner has set forth no objective basis for combining the teachings of the references in the manner used by this rejection. Further, the Examiner has selected the helpful portions from each reference while ignoring the unhelpful portions. An objective basis is one set forth in the art or which can be established by a declaration, not one that can be developed in light of the present disclosure. If the rejection is maintained, Applicants ask that the Examiner set forth the objective basis found in the references themselves for combining the teachings of the references, for adopting only the helpful teachings of each reference and disregarding the unhelpful teachings of the reference, and for achieving the determination of the modules to be added to an intranet portal as found in Applicants' claimed invention.

While the intranet is referred to in Cohen as a means for distributing information, there is no teaching that a module in an intranet portal is itself is being updated. *See e.g.*, col. 1, lines 6-11: "...exporting technology standards...via an intranet."; col. 4, lines 17-20: "...transmits standard documents formatted into web pages over the intranet..."; col. 10, lines 53-57: "...displayed on a computer that is linked through the intranet..." Furthermore, Cohen's standard is simply not the same as the module of Applicants' claimed invention. The standards described in Cohen are documents, *see, e.g.*, col. 1, lines 51-52, while Applicants' modules are described at [0016] of the specification as originally filed: small pieces of functionality or applications to supply or provide access to data, applications, information and processes. Thus, a module might provide access to a standards document like those described in Cohen, but the standards document is not itself a module.

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Applicants' incorporate by reference the arguments previously presented in the Paper filed December 23, 2004, which clearly differentiates Cohen from Applicants' claimed invention.

Restating the rejection of the prior Office Action to add Anuff in combination with Cohen still fails to overcome the deficiencies of Cohen. Anuff appears to be cited only for the proposition that intranet portals may include modules and that an administrator can determine which modules get added. Office Action at page 5. Applicants find nothing in Anuff that teaches, discloses or suggests that the basis for determining the module to be added, much less that the determination is made in the same way as the Applicants' claimed invention.

Thus, Cohen still lacks any teaching or suggestion that modules of the intranet, not documents transferred over an intranet, are modified. Even if one of ordinary skill in the art were to combine the teachings of Anuff with those of Cohen, at most one would only achieve a method for creating a standards document that could be transferred over an intranet, which intranet includes modules added by an administrator. Applicants find nothing in either of the cited references that supports the Examiner's position that Cohen's standards documents that are transferred over an intranet are interchangeable with modules of the intranet itself, much less that a method of determining what standards document should be included in a database of such documents would be the same as determining which modules should be included on the intranet over which the standards documents are transferred.

In response to the Applicants' remarks at page 10 of the Office Action, the Examiner states that Anuff overcomes Applicants' prior arguments because Anuff teaches modules and an administrator. Yet, the Examiner provides no basis to equate the standards documents of Cohen with the modules of Anuff. Further, the only motivation provided by the Examiner to combine

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Cohen and Anuff is "to reduce the cost of maintenance of a portal." Office Action at page 5. However, it would appear that since the Examiner admits that Cohen fails to teach an administrator determining a module to be added, combining Anuff would likely increase costs by introducing new personnel or new duties for existing personnel. Furthermore, it appears that a determination by an administrator would conflict with the open voting procedures of Cohen. As understood by Applicants, Cohen appears to require that the vote itself is the determining factor as to whether a standards document is added/modified. See Cohen, col. 14, line 55—col. 15, line 20.

In response to the Examiner's comments on Applicants' arguments regarding a cumulative indication, Applicants respectfully submit that the Examiner still fails to appreciate that Cohen appears to only teach counting all of the votes after they have been cast, ignoring the incremental counting of indications of support suggested by the use of the term "cumulative."

Thus, even in combination, Cohen and Anuff fail to teach, disclose or suggest each and every limitation of Applicants' claimed invention. As a prima facie case of obviousness has not been presented, the rejection of independent claims 1, 9 and 21, and all claims depending therefrom, should be withdrawn.

B. Claims 15 and 16

Claims 15 and 16 stand rejected as assertedly obvious over Cohen and Anuff in further view of Sprague. Applicants respectfully traverse the rejection.

Claims 15 and 16 both depend from claim 9 which has been shown above to be allowable. Furthermore, Sprague is believed to be cited only for its teaching that support can be expressed in the form of a rating and fails to overcome the deficiencies of Cohen shown above

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with respect to independent claims 1, 9 and 21. Thus, claims 15 and 16 are also allowable and the rejection should be withdrawn.

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CONCLUSION

For at least the foregoing reasons, Applicants respectfully request reconsideration of the Application and withdrawal of the outstanding rejections. Applicants respectfully submit that claims 1-6, and 8-21 are not anticipated by, nor rendered obvious by, Cohen, Anuff or Sprague, and thus, are in condition for allowance. Applicants request allowance of claims 1-6 and 8-21 in a timely manner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicants' undersigned representative.

This Amendment/Response is filed within three (3) months of the mailing date of the Office Action and it is believed that no fee is due with the filing of this paper. In event that Applicants are mistaken in their calculations, the Commissioner is authorized to deduct any fees determined by the Patent Office to be due from the undersigned's Deposit Account No. 50-1059.

Date: August 19, 2005

Respectfully submitted,

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By:

A handwritten signature in black ink, appearing to read 'Shawn K. Leppo', is written over a horizontal line. To the right of the signature, the number '50,311' is handwritten.

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